

Appl. No.: 10/722,966
Reply to Office Action of: 04/30/2007

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REMARKS

Claims 1-21, 23, and 24 were rejected under 35 U.S.C. §103(a) as being unpatentable over Gouzman et al. (US 6,762,749) in view of Marcus et al. (US 2005/0093846) and Rosenberg (US 5,691,898). Claim 22 was rejected under 35 U.S.C. §102(e) as being anticipated by Hunt et al. (US 7,031,761). The examiner is requested to reconsider these rejections.

To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974).

Claim 1 has been amended to clarify applicants' claimed invention. In particular, claim 1 claims a user interface for changing an operational mode of the electronic device from a first operational mode of the device to a second operational mode of the device; and a processor operable to enable the actuator during the first mode of the device and disable the actuator during the second mode of the device, wherein the actuator provides the first texture at the first portion when the electronic device is in the first operational mode, wherein the actuator provides the second texture at the first portion when the electronic device is in the second operational mode, and wherein the first portion is spaced from the user interface. The features of claim 1 are not disclosed or suggested in the cited art.

Gouzman discloses a fully integrated tactile interface system (FITIS) 200, similar to a mouse, connected to a computer and having buttons 204 and embossed tactile displays (ETD) 202.

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The embossed tactile displays (ETD) 202 are used for the computer to give tactile feedback to the user based upon mouse-like actions; such as navigation and selections. The examiner admits that Gouzman does not mention that the actuator provides the first texture at the first portion when the electronic device is in the first operational mode, and wherein the actuator provides the second texture at the first portion when the electronic device is in the second operational mode.

Marcus discloses a human interface system that provides tactile feedback to a user to indicate an event of interest in the software application (see paragraph [0075]). However, Marcus does not disclose or suggest that the actuators provide a first tactile feedback when the electronic device is in a first operational mode and that the actuators provide a second tactile feedback when the electronic device is in a second operational mode. In fact, Marcus does not disclose any association between different modes of operation of the electronic device and the actuators or the tactile feedback. Instead Marcus discloses that the tactile feedback is provided "to indicate the momentary achievement of an objective, such as a target lock in game applications" (see paragraph [0075]).

With applicants' invention a mobile cellular telephone can be provided with a rough textured surface on its back cover when the mobile telephone is in a mute mode (a first operational mode) and a smooth surface when the telephone is not in a mute mode (a second operational mode). As another example, with applicants' invention a mobile cellular telephone can be provided a rough textured surface on both of its lateral sides

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when the mobile telephone is being used for gaming (a first operational mode) and a smooth textured surface on both of its lateral sides when the mobile telephone is not being used for gaming (a second operational mode). These are only some examples noted in the patent application which illustrate the features of claim 1. More specifically, claim 1 provides a device where the texture on the device can be changed based upon an operational mode of the device. This is not disclosed or suggested in the cited art.

Rosenberg discloses a computer peripheral with force feedback for consumer applications. The examiner states that Rosenberg teaches a computer peripheral system that includes a switch to enable and disable actuators by a user (while admitting that neither Gouzman nor Marcus discloses a processor operable to enable the actuator during the first mode and disable the actuator during the second mode). However, Rosenberg discloses that the actuators 30 generate forces on to a user object (joystick) 34 in response to host commands from a host computer (see col. 50, lines 50-58). As opposed to applicants' claimed invention where the actuators change a texture (at a first portion away from the user interface) on the device based upon an operational mode of the device.

Applicants submit that there is no suggestion to combine the references as the examiner is attempting to do (at least not until after reading applicants' patent application). In particular, both Marcus and Rosenberg teach that the tactile feedback is provided at the user input. For example, Marcus discloses tactile feed back at the two input elements (rotary dials) 754, 756 (see paragraph [0072]). And Rosenberg

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discloses tactile feedback at the user object (joystick) 34 (see col. 50, lines 50-58). Applicants' claimed invention claims a texture on a first portion of the device that can be changed based upon an operational mode of the device, wherein the first portion is spaced from the user interface. There is no mention or suggestion in the cited art to combine the processor and actuator providing tactile feedback at the rotary dials and joystick (disclosed in Marcus and Rosenberg) with the embossed type tactical displays 202 spaced from the selector devices (buttons/user inputs) 204 disclosed in Gouzman.

Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. (see MPEP 2143.01, page 2100-98, column 1). The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination (see MPEP 2143.01, page 2100-98, column 2). A statement that modifications of the prior art to meet the claimed invention would have been "well within the ordinary skill of the art at the time the claimed invention was made" because the references relied upon teach that all aspects of the claimed invention were individually known in the art is **not sufficient** to establish a prima facie case of obviousness without some objective reason to combine the teachings of the references. (see MPEP 2143.01, page 2100-99, column 1) Ex parte Levengood,

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28 USPQ2d 1300 (Bd. Pat. App. & Inter. 1993). >See also Al-Site Corp. v. VSI Int'l Inc., 174 F.3d 1308, 50 USPQ2d 1161 (Fed. Cir. 1999) (The level of skill in the art cannot be relied upon to provide the suggestion to combine references.)

In the present case, there is no teaching, suggestion, or motivation, found in either the references themselves or in the knowledge generally available to one of ordinary skill in the art, to provide a user interface for changing an operational mode of the electronic device from a first operational mode of the device to a second operational mode of the device; and a processor operable to enable the actuator during the first mode of the device and disable the actuator during the second mode of the device, wherein the actuator provides the first texture at the first portion when the electronic device is in the first operational mode, wherein the actuator provides the second texture at the first portion when the electronic device is in the second operational mode, and wherein the first portion is spaced from the user interface as claimed in claim 1. The features of claim 1 are not disclosed or suggested in the art of record. Therefore, claim 1 is patentable and should be allowed.

Claims 2-21 depend either directly or indirectly from claim 1 and thus include all the limitations of claim 1. Thus, claims 2-21 are believed to be allowable for at least the reasons given for claim 1.

Claim 23 has been amended to clarify applicants' claimed invention. In particular, claim 23 claims providing a first configuration of a surface area of the electronic device;

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receiving user input at the electronic device to change an operational mode of the device; and providing a second configuration of the surface area of the electronic device instead of the first configuration based upon the user input changing the operational mode of the device. Similar to the arguments presented above with respect to claim 1, the features of claim 23 are not disclosed or suggested in the art of record. As admitted by the examiner, Gouzman does not mention different operational modes or changes in configuration based upon the different operational modes. Marcus discloses tactile feedback based on software application events such as a "target lock" in a game application (as opposed to different operational modes of the device). And Rosenberg discloses actuators 30 generating forces on to a user object (joystick) 34 in response to host commands from a host computer (as opposed to receiving user input at the electronic device to change the operational mode of the device).

Neither Gouzman, Marcus, nor Rosenberg teach or suggest providing a first configuration of a surface area of the electronic device; receiving user input at the electronic device to change an operational mode of the device; and providing a second configuration of the surface area of the electronic device instead of the first configuration based upon the user input changing the operational mode of the device as claimed in applicants' claimed invention.

Additionally, applicants submit that there is no suggestion to combine the references as the examiner is attempting to do (at least not until after reading applicants' patent application).

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In the present case, there is no teaching, suggestion, or motivation, found in either the references themselves or in the knowledge generally available to one of ordinary skill in the art, to provide a first configuration of a surface area of the electronic device ... receive user input at the electronic device to change an operational mode of the device ... and provide a second configuration of the surface area of the electronic device instead of the first configuration based upon the user input changing the operational mode of the device as claimed in amended claim 23. The features of claim 23 are not disclosed or suggested in the art of record. Therefore, claim 23 is patentable and should be allowed.

Claim 24 has been amended to clarify applicants' claimed invention. In particular, claim 24 claims an actuator coupled to the processor, wherein the processor is adapted to change a texture of a portion of the housing based upon an operational mode of the device feature application. Similar to the arguments presented above with respect to claim 1, the features of claim 24 are not disclosed or suggested in the art of record. As admitted by the examiner, Gouzman does not mention changes in configuration/texture based upon the different operational modes. Marcus discloses tactile feedback based on software application events such as a "target lock" in a game application (as opposed to different operational modes). And Rosenberg discloses actuators 30 generating forces on to a user object (joystick) 34 in response to host commands from a host computer (as opposed to receiving user input at the electronic device to change the operational mode of the device).

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Neither Gouzman, Marcus, nor Rosenberg teach or suggest an actuator coupled to the processor, wherein the processor is adapted to change a texture of a portion of the housing based upon an operational mode of the device feature application as claimed in applicants' claimed invention.

Additionally, applicants submit that there is no suggestion to combine the references as the examiner is attempting to do (at least not until after reading applicants' patent application). In the present case, there is no teaching, suggestion, or motivation, found in either the references themselves or in the knowledge generally available to one of ordinary skill in the art, to provide an actuator coupled to the processor, wherein the processor is adapted to change a texture of a portion of the housing based upon an operational mode of the device feature application as claimed in amended claim 24. The features of claim 24 are not disclosed or suggested in the art of record. Therefore, claim 24 is patentable and should be allowed.

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). It is submitted that Hunt fails to teach each and every element as set forth in claims 22 for at least the reasons described below.

Applicants have amended claim 22 to recite, *inter alia*, "means for providing, when enabled, a first texture at a first portion of the exterior surface, and when disabled, a second

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texture at the first portion of the exterior surface". In contrast, Hunt merely discloses a mobile cellular telephone 200 comprising a cellular transceiver portion 202 and a physically separate and distinct user input/output portion 204. The casing for the cellular transceiver portion 202 may be customized according to a user's specification at manufacture so that the telephone, when delivered to the user, has ornamentation specific to the user's taste (see col. 4, lines 49-52). The user input/output portion 204 is contained in an ornamental housing which is customized at manufacture to a user's specification (see col. 4, lines 53-55). However, there is no disclosure or suggestion that either the cellular transceiver portion 202 or the user input/output portion 204 provide a first texture at a first portion of the exterior surface (when enabled) and a second texture at the first portion of the exterior surface (when disabled). Thus, Hunt fails to teach the features recited in claim 22. Accordingly, claim 22 is patentable over the art of record and should be allowed.

For all of the foregoing reasons, it is respectfully submitted that all of the claims now present in the application are clearly novel and patentable over the prior art of record. Accordingly, favorable reconsideration and allowance is respectfully requested. Should any unresolved issue remain, the examiner is invited to call applicants' attorney at the telephone number indicated below.

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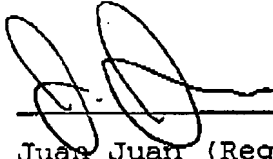
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Respectfully submitted,



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